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Joseph P. Baumgartner

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ROPES & GRAY LLP

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EXAMINER

HANCE, ROBERT J

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/762,833	Applicant(s) BAUMGARTNER ET AL.	
	Examiner ROBERT HANCE	Art Unit 4134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 43-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 43-56 define machine-readable media embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for that

reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed machine-readable media can range from paper on which the program is written, to a program simply contemplated and memorized by a person.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 6-11, 15, 20-25, 29, 34-39, 43, and 48-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Wugofski, US Patent No. 7,134,133.

As to claim 1, Wugofski discloses a method for providing a media-on-demand display screen using an interactive television application implemented on user equipment (col. 7 lines 3-20 – templates are for broadcast channels, as well as media-on-demand. EPG templates provide access to transaction-based services), the method comprising: retrieving an interface template (col. 7 lines 15-25); retrieving at least one vendor-specific interface element (col. 6 line 56 – col. 7 line 46) ; incorporating the at

least one vendor- specific interface element into the interface template (col. 7 lines 16-25; col. 8 lines 12-36); and displaying a media-on-demand display screen that is associated with the vendor, wherein the display includes the interface template and the incorporated interface element (col. 8 lines 12-36).

As to claim 6, Wugofski discloses the method of claim 1, wherein the retrieving the interface template comprises providing the interface template to the interactive television application by a remote server (col. 7 lines 16-20; Fig. 2).

As to claim 7, Wugofski discloses the method of claim 1, wherein the retrieving the vendor-specific interface elements comprises providing the vendor-specific interface elements to the interactive television application by a remote server (col. 7 lines 16-33).

As to claim 8, Wugofski discloses the method of claim 1, wherein the retrieving the vendor-specific interface elements comprises accessing the vendor-specific interface elements stored locally on the user equipment (col. 7 line 47 - col. 8 line 36 – see application storage module 403; Fig. 4 – GUI assets module is local and contains vendor information).

As to claim 9, Wugofski discloses the method of claim 1, wherein the interactive television application comprises an interactive program guide, the method further comprising using the interactive program guide to display the media-on-demand display

screen on the user equipment (col. 7 lines 3-15 – EPG provides access to transaction-based services, implying media-on-demand requests by users).

As to claim 10, Wugofski discloses using the interactive television application to display multiple media-on-demand display screens on the user equipment, wherein each of the media-on-demand display screens is associated with a different media-on-demand vendor (col. 7 lines 16-19 – at least one template is received; col. 8 lines 7-30 – additional information for each of the networks and pay-per-view stations is kept in memory).

As to claim 11, Wugofski discloses the method of claim 1, wherein the media-on-demand display screen includes video-on-demand listings, the method further comprising displaying the video-on-demand listings as part of the vendor-specific media-on-demand display screen (col. 7 lines 3-15 – templates are for broadcast channels, as well as media-on-demand. EPG templates provide access to transaction-based services).

As to claims 15, 20-25, see similar rejection to claims 1, 6-11. The user equipment of claims 15-28 corresponds to the method of claims 1, 6-11. Therefore claims 15, 20-25 have been analyzed and rejected based upon method claims 1, 6-11, respectively.

As to claims 29, 34-39, see similar rejection to claims 1, 6-11. The system of claims 29, 34-39 corresponds to the method of claims 1, 6-11. Therefore claims 29, 34-39 have been analyzed and rejected based upon method claims 1, 6-11, respectively.

As to claims 43, 48-53, see similar rejection to claims 1, 6-11. The machine-readable media of claims 43-56 corresponds to the method of claims 1, 6-11. Therefore claims 43, 48-53 have been analyzed and rejected based upon method claims 1, 6-11, respectively. Wugofski states that the invention can be carried out in software (Abstract).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2-3, 5, 12-14, 16-17, 19, 26-28, 30-31, 33, 40-42, 44-45, 47 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wugofski, US Patent No. 7,134,133 in view of Schowtka, Pub. No. US 2005/0007382 A1.

As to claim 2, Schowtka discloses a template including an invariant element (Paragraph 45 and Fig. 7b – 703 is a non-image area and does not change, regardless of image content).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the template design disclosed by Schowtka with the EPG templates disclosed by Wugofski. The rationale for this combination would have been to create a more visually appealing program guide and to better handle errors when station-specific elements are missing. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claim 3, Schowtka discloses a template including at least one default element (Paragraph 54 – a default image is supplied to substitute for one or more missing images).

As to claim 5, Schowtka discloses determining if an element is absent and incorporating the default element that corresponds to the absent element into the template (Paragraph 54 – a default image is supplied to substitute for one or more missing images).

As to claim 12, Schowtka discloses a template with user- specified definitions where the display of the final product complies with the definitions set by the user (Paragraph 8).

As to claim 13, Schowtka discloses user-specified definitions including color definitions (Paragraph 8).

As to claim 14, Schowtka discloses user-specified definitions including pattern definitions (Paragraph 42 – templates have elements such as lines, shapes, i.e. patterns).

As to claims 16-17, 19 and 26-28, see similar rejection to claims 2-3, 5 and 12-14. The user equipment of claims 15-28 corresponds to the method of claims 2-3, 5 and 12-14. Therefore claims 16-17, 19 and 26-28 have been analyzed and rejected based upon method claims 2-3, 5 and 12-14, respectively.

As to claims 30-31, 33 and 40-42, see similar rejection to claims 2-3, 5 and 12-14. The system of claims 29-42 corresponds to the method of claims 2-3, 5 and 12-14. Therefore claims 30-31, 33 and 40-42 have been analyzed and rejected based upon method claims 2-3, 5 and 12-14, respectively.

As to claims 44-45, 47 and 54-56 see similar rejection to claims 2-3, 5 and 12-14. The machine-readable media of claims 44-45, 47 and 54-56 corresponds to the method of claims 2-3, 5 and 12-14. Therefore claims 44-45, 47 and 54-56 have been analyzed and rejected based upon method claims 2-3, 5 and 12-14, respectively. All

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references cited in the rejection of claims 2-3, 5 and 12-14 state that the inventions can be carried out in software (Schowtka Paragraph 33; Wugofski Abstract).

5. Claims 4, 18, 32 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wugofski, US Patent No. 7,134,133 in view of Schowtka, Pub. No. US 2005/0007382 A1, in further view of Weinberger et al. US Patent No. 7,028,304.

As to claim 4, Weinberger et al. disclose determining if an element is inappropriate for incorporation and incorporating a default element that corresponds to the inappropriate element (col. 20 lines 41-45 – data inconsistent with the layout of the airplane (i.e. inappropriate data) is replaced with default database information).

It would have been obvious to one of ordinary skill in the art to combine the teachings of Weinberger et al. with the template scheme disclosed by Schowtka. The rationale for this combination would have been to provide a default image screen not only when an image is missing, as Schowtka describes in Paragraph 54, but also when an image set is inappropriate for the given template. All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

As to claims 18, see similar rejection to claim 4. The user equipment of claim 18 corresponds to the method of claim 4. Therefore claim 18 has been analyzed and rejected based upon method claim 4.

As to claims 32, see similar rejection to claim 4. The system of claim 32 corresponds to the method of claim 4. Therefore claim 32 has been analyzed and rejected based upon method claim 4.

As to claims 46, see similar rejection to claim 4. The machine-readable media of claim 46 corresponds to the method of claim 4. Therefore claim 46 has been analyzed and rejected based upon method claim 4. All three references cited in the rejection of claim 4 state that the inventions can be carried out in software (Schowtka Paragraph 33; Weinberger Abstract; Wugofski Abstract).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HANCE whose telephone number is (571)270-5319. The examiner can normally be reached on M-F 8:00am - 5:00am EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derrick Ferris can be reached on (571) 272-3123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. H./

Examiner, Art Unit 4134

/Derrick W Ferris/

Supervisory Patent Examiner, Art Unit 4134